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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,470	08/14/2006	Koji Sato	062893	7241
38834 7590 10/15/2008 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER SHEEHAN, JOHN P				
ART UNIT 1793		PAPER NUMBER		
MAIL DATE 10/15/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/589,470

Applicant(s)

SATO ET AL.

Examiner

John P. Sheehan

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1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTIO

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 to 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- I. In the new claim limitation, "an inner diameter of up to 90mm and an (inner diameter)/(outer diameter) ratio from 0.3 to 0.7" (claim 1, the last two lines), the phrase, "an inner diameter of up to 90mm" and the lower limit of 0.3 for the (inner diameter)/(outer diameter) ratio do not find support in the application as filed and therefore is new matter.

- II. In claim 4, the lower limit of 0.43 in the new claim limitation, "the (inner diameter)/(outer diameter) ratio being from 0.43 to 0.67" (claim 4, the last line) does not find support in the application as filed and therefore is new matter. Applicants appear to consider Example 2 of the

specification as support for the lower limit of 0.43, however, Example 2 teaches an (inner diameter)/(outer diameter) ratio of 0.47 (3.7mm/8 mm).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 to 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over each of Sato et al. (Sato '970, EPO Document No. EP 1 308 970 A2, cited in the IDS submitted October 16, 2007); Sato et al. (Sato '944, Japanese Patent Document No. 2004-111944, cited in the IDS submitted August 14, 2004); and Sato et al. (Sato '867, Japanese Patent Document No. 2004-153867, cited in the IDS submitted August 14, 2006).

Each of the references teaches a process that is encompassed by the process recited in applicants' claims 1 to 3 (see, Sato '970, pages 6 and 7, paragraphs [0027] and [0028]; Sato '944, paragraphs [0014] and [0032]; and Sato '867, paragraphs [0020] and [0024]).

The claims and the references differ in that the references do not teach "an inner diameter of up to 90mm and an (inner diameter)/(outer diameter) ratio from 0.3 to 0.7" (claim 1, the last two lines) nor "the (inner diameter)/(outer diameter) ratio being from 0.43 to 0.67" (claim 4, the last line).

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because, with the exception of the specific examples in each of the references, the references do not contain any disclosure limiting the maximum inner diameter nor the (inner diameter)/(outer diameter) ratio of the disclosed radially anisotropic annular sintered magnets. The teachings of a reference are not limited to merely that which is set forth in the examples. Instead “[a] reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art”, see MPEP 2123 and In re Widmer, 147 USPQ 518, 523 (CCPA 1965). Thus, the maximum inner diameter and the (inner diameter)/(outer diameter) ratio set forth in the examples taught by the references are not considered to limit the references. Therefore the teachings of these references are considered to encompass any maximum inner diameters and (inner diameter)/(outer diameter) ratios that function for the purpose of the inventions disclosed by each of the references, including the values recited in the instant claims. Further, a change in the size of a product does not lend patentability to the product, MPEP 2144.04.

IV. CHANGES IN SIZE, SHAPE, OR SEQUENCE OF ADDING INGREDIENTS

A. Changes in Size/Proportion

In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package “of appreciable size and weight requiring handling by a lift truck” where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (“mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled.” 531 F.2d at 1053, 189 USPQ at 148.).

In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Finally, as set forth in the table spanning pages 6 and 7 of applicants' remarks submitted June 30, 2008 Sato '867 (equivalent to Sato '970) and Sato '944 teach (inner diameter)/(outer diameter) ratios of 0.79 and 0.73 respectively, which closely approximate the upper limit of the (inner diameter)/(outer diameter) ratios of 0.7 and 0.67 recited in applicants' claims 1 and 4.

5. Claims 1 to 4 are directed to an invention not patentably distinct from claims 1 to 5 of U.S. Patent No. 7,201,809 and claims 1 to 7 of U.S. Patent No. 6,984,270 which are commonly. Specifically, although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed process in '270 and '809 overlap the instantly claimed process. A prima facie case of obviousness exists when the claimed invention overlaps the disclosed prior art *In re Geisler* 43 USPQ2d 1365 (Fed. Cir. 1997); *In re Woodruff*, 16 USPQ2d 1934 (CCPA 1976); *In re Malagari*, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

6. Claims 1 to 4 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent Nos. 7,201,809 and 6,984,270.

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2). Each of the references discloses a process that overlaps the process recited in applicants' claims 1 to 3 (see, 6,984,270, column 6, line 36 to column 7, line 13; and column 13, lines 35 to 47; and 7,201,809, column 3, line 40 to column 4, line 15; and column 8, line 56 to column 9, line 18). A prima facie case of obviousness exists when the claimed invention overlaps the disclosed prior art In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Response to Arguments

7. Applicant's arguments filed June 30, 2008 have been fully considered.
8. The obvious double patenting rejections based on each of 7,201,809 and 6,984,270 have been overcome in view of the Terminal Disclaimer submitted June 30, 2008. The Terminal Disclaimer does not overcome the rejections of the claims under 35 U.S.C. 103 based on each of 7,201,809 and 6,984,270.
9. Applicants argue that the references do not teach the (inner diameter)/(outer diameter) ratios recited in the claims. The Examiner is not persuaded for the reasons set forth above in the new statement of the rejection written in response to the applicants' amendments to the claims.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (7:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Sheehan/
Primary Examiner
Art Unit 1793

Jps